

Remarks:

Applicant has read and considered the Office Action dated September 1, 2010 and the references cited therein. Claims 1-24 and 26-27 have been amended. Claims 1-27 are currently pending. Reconsideration is hereby requested.

In the Action, claims 1, 9, 17 and 26-27 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Action stated it is not clear if the embedded program is the bar code itself, which gets distributed in the copy of electronic document data or if the embedded program is a control program that controls processing to derive instructions to generate commands to print geometrical elements of a bar code. Clarification was requested. The claims have now been amended to positively recite both a control program with instructions as well as a bar code included in electronic document data. Claim 1 recites electronic document data containing printing instructions, which represents the bar code. Moreover, claim 1 also recites an embedded control program with processing instructions linked to the user data input field. It is clear from all of the claims that the control program provides instructions to generate commands to print geometrical shapes of the bar code in electronic document data. Applicants assert that the claims are now definite and overcome the rejection under 35 U.S.C. § 112, second paragraph. Applicant therefore requests that the rejection be withdrawn.

Claims 2-6 and 8 were rejected as there is insufficient antecedent basis for “the embedded instruction” in the claims. The claims have been amended to recite an embedded control program with processing instructions. Applicant asserts that there is sufficient antecedent basis for this limitation. Applicant requests that the rejection be withdrawn.

Claims 1, 9, 17 and 26-27 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Action stated that the claims under the broadest reasonable interpretation are drawn to a recording medium that covers both transitory and non-transitory

embodiments. The Action suggested adding the limitation “non-transitory” to the claims. Although Applicant does not acquiesce in the rejection, the claims have been amended to recite a “non-transitory” medium. Applicant asserts that the claims now recite statutory subject matter and request that the rejection under 35 U.S.C. § 101 be withdrawn.

Claims 1-8 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Xu et al. and Wu et al., and further in view of Marshall. In addition, claims 17-25 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Xu et al., in view of Marshall. Finally, claims 9-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Xu et al., Marshall and Koakutsu et al. Applicant respectfully traverses the rejections.

Applicant further notes that in the Response to Arguments, the Office Action stated that the arguments are not necessarily directed to a program embedded in the document and only to security codes embedded in the bar code. Applicant further notes that the Examiner requests explanation of the “embedded program.”

The claims have now been amended to recite an embedded control program with processing instructions. Moreover, the claims now also recite a separate bar code in the electronic document data. The claims clarify that the bar code is separate from the embedded control program. In the present invention, the instructions are part of the control program and execution of the instructions results in generation of commands and the commands control the printer. See for example, the paragraph beginning on page 11, line 8, as well as page 9, lines 8-9 and 18-19 regarding an explanation of “embedded.” Applicant notes that the claims recite that an embedded control program with instructions is recited. Moreover, the embedded program is linked to the user input field and that the instructions instruct processing to generate commands to print geometrical elements representing codewords derived from characters in a string from the user input field. Applicant asserts that the clarification of the embedded program provides claims that patentably distinguish over the prior art. Applicant asserts that none of the cited

references teach or suggest the method, electronic form or machine recited in the claims. Moreover, Applicant notes that the passage relied upon in Marshall only recites a computer program for embedding security features, but does not actually teach an embedded program. Nothing in the cited references, including the cited passages, teaches or suggests that the bar code is a program or that the program would be embedded in the document. Applicant further notes that the cited passages also only teach that the patterns of the bar code can be programmed and illustrates only the patterns of the bar code and does not teach or suggest the embedded control program providing instructions to generate commands from the user input field dependent on the code words representing a bar code or portions of the bar code from the string of the user input field. Therefore, Applicant asserts that the claims patentably distinguish over the cited references or any combination thereof. Applicant requests that the rejections under 35 U.S.C. § 103(a) be withdrawn.

Applicant further notes that the Examiner has been very gracious and has agreed to discuss the application and claim language in the past. Applicant would welcome a further interview to discuss the claims if for any reason the currently pending claims are not believed to place the application in condition for allowance.

A speedy and favorable action in the form of a Notice of Allowance is hereby solicited. If the Examiner feels that a telephone interview may be helpful in this matter, please contact Applicant's representative at (612) 336-4728.

U.S. Patent Application Serial No. 10/627,348
Reply to Office Action dated September 1, 2010

Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to enter these papers or any future reply, if appropriate. Please charge any additional fees or credit overpayment to Deposit Account No. 13-2725.



Dated: 1/3/11

Respectfully submitted,

MERCHANT & GOULD P.C.

By: 
Gregory A. Sebald
Reg. No. 33,280
GAS/krn